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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,883	01/26/2004	Kermit D. Lopez	1000-1372	9695
7590	06/25/2004		EXAMINER	
ORTIZ & LOPEZ, PLLC			JANVIER, JEAN D	
Patent Attorneys			ART UNIT	PAPER NUMBER
P.O. Box 4484			3622	
Albuquerque, NM 87196-4484				

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/764,883	LOPEZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jean D Janvier	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
**THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 26 January 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____ .                                  |

**DETAILED ACTION**

**Specification**

**Priority Information**

This Application is a divisional Application of Parent co-pending Application SN 09/684, 737, filed on October 06, 2000.

**Status of the claims**

Claims 1-20 are currently pending in the present Application.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Guthrie et al. (hereinafter Guthrie), US Patent 6,467,686 B 1.

As per claims 1 and 6, Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any other computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle. The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, the user can take the coupon scanner to a retail store where he can redeem the electronic coupons at the retail store checkout through a POS cradle (docking station 22 of figs. 1, 6 and 7) located at the checkout used to upload or transfer the coupon data from the coupon scanner to the retail store system during a redemption process (synchronization of POS and handheld device) (Col. 4: 64 to col. 5: 24).

As per claims 4-5, 10-13 and 15, Guthrie discloses a system for providing electronic coupons (new coupon data) or negotiable economic credits to a user over the Internet or any computer network having a server containing a central repository or database (coupon source) storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle during an interaction or synchronization between the central repository and the coupon scanner. The stored

coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, the user can take the coupon scanner to a retail store where he can redeem the electronic coupons at the retail store checkout through a POS cradle (docking station 22 of figs. 1, 6 and 7, infrared device interface or wireless device interface) located at the checkout used to upload or transfer the coupon data from the coupon scanner to the retail store system (synchronization of POS and handheld device) and wherein the cradle is an infrared transceiver device interface or wireless device interface. In other words, a wireless connection (wireless communication network) is used during the synchronization process between the coupon scanner or the handheld device and the retail store POS system to transfer coupon data related to at least one electronic coupon or negotiable economic credit from the coupon scanner to the retail store POS system (Col. 4: 64 to col. 5: 24; See claims 1, 8 and 22 of the current reference), (Col. 4: 64 to col. 5: 24; col. 7: 48 to col. 8: 24; col. 8: 66 to col. 9: 34) and (col. 8: 66 to col. 9: 34).

As per claims 14, 2-3 and 7-9, Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any other computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle (docking station 22 of figs. 1, 6 and 7). In an alternate embodiment, the coupon data are read from a static reference, such as a static paper or a paper coupon 25, and scanned into the coupon scanner memory or internal database

by running the scanner face of the scanner device portion (bar code scanner or optical device or laser scanner) of the customer's portable device over the scannable section of the coupon 25 (such as a bar code 23) (using a bar code scanner, laser scanner or optical scanner related to the handheld device to scan and upload the coupon data into the user's portable device memory-figs. 1 and 8; col. 4: 5-24; col. 8: 25 to col. 9: 6; see also claims 12, 13-14 and 18 of the present reference). In the portable device memory, the stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Furthermore, the coupon scanner further contains routines or a coupon management program (coupon management module) within its memory or database for managing the storage and usage of the electronic coupon data within the memory of the coupon scanner or handheld device (col. 5: 25-36; col. 8: 15-65; col. 9: 33-34). Finally, once the user has uploaded the coupon scanner or handheld device with the desired coupon data, representing all desired coupons 25, then the user can take the coupon scanner to a retail store where he can redeem the electronic coupons at a retail store checkout through a POS cradle (docking station 22 of figs. 1, 6 and 7, infrared device interface or wireless device interface) located at the checkout used to upload or transfer the coupon data from the coupon scanner to the retail store system (synchronization of POS and handheld device) and wherein the cradle is an infrared transceiver device interface or wireless device interface. In other words, a wireless connection (wireless communication network) is used during the synchronization process between the coupon scanner or the handheld device and the retail store POS system to transfer coupon data related to at least one electronic coupon or negotiable economic credit from the coupon scanner to the retail store

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POS system (Col. 4: 64 to col. 5: 24; See claims 1, 8 and 22 of the current reference), (Col. 4: 64 to col. 5: 24; col. 7: 48 to col. 8: 24; col. 8: 66 to col. 9: 34) and (col. 8: 66 to col. 9: 34).

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guthrie in US Patent 6, 467, 686B1.

As per claims 16-20, Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any computer network having a server containing a central repository or database (coupon source) storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle during an interaction or synchronization between the central repository and the coupon scanner. The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, the user can take the coupon scanner to a retail store where he can redeem the electronic coupons at the retail store checkout through a POS cradle (docking station 22 of figs. 1, 6 and 7, infrared device interface or **wireless device** (interface or wireless network) located at the checkout used to upload or transfer the coupon data from the coupon scanner to the retail store system (synchronization of POS and handheld device) and wherein the cradle is an infrared transceiver device interface or wireless device interface. In other words, a wireless connection (wireless communication network) is used during the synchronization process between the coupon scanner or the handheld device and the retail store POS system to transfer coupon data related to at least one electronic coupon or negotiable economic credit from the coupon scanner to the retail store POS system (Col. 4: 64 to col. 5: 24; See claims 1, 8 and 22 of the current reference). In short, Guthrie supports transferring a credit or coupon, stored in the memory of the customer's handheld device, from the handheld device to a store POS system to thereby perform a redemption and wherein the transferring or synchronization is conducted in a wireless mode.

Here, Guthrie does not explicitly disclose using a wireless personal area network, a Bluetooth network, a paging network, a Wireless Intelligent Network (WIN) or a CDMA network as opposed to a regular wireless network (such as a RF or IR as supported in the reference) during the transfer of data (synchronization process) between the customer's handheld device and the store POS system.

However, using a wireless personal area network, a Bluetooth network, a Wireless Intelligent Network (WIN), a paging network or a CDMA network as opposed to a regular wireless network (such as a RF or IR as supported in the reference) during the transfer of data (synchronization process) between the customer's handheld device and the store POS system is a matter of desires, design choice, design consideration or great convenience, which does not directly impact the utility or functionality of the system or simply the transfer of coupon data or credit information between the handheld device and the store POS system to thereby perform a redemption or provide a credit to the customer during a transaction at the POS, wherein the coupon data are transmitted from the handheld device to the POS system during the synchronization process.

The latter findings (conclusion) are well within the skills of an ordinary artisan. Further, Guthrie never limits his system to a specific wireless network. In other words, broadly interpreting the teachings of Guthrie, the use of other well known wireless networks or technologies are herein expected as would have understood one of ordinary skill in the art.

Therefore, an ordinary skilled artisan, reading or using the system of Guthrie, would have reached the above conclusion and would have been motivated at the time of the invention to consider utilizing other wireless networks to transmit coupon data or credit information between the customer's handheld device and the store POS system to thereby rendering the system more flexible by including other stores that may have installed other wireless networks at their locations instead of an RF or IR system, as disclosed by Guthrie, to perform data transmission between the customer's handheld device and the other store POS systems.

### **Conclusion**

The following references, although not officially used, are considered to be highly relevant.

US Patent 6,505,773B1 to Palmer discloses an online coupon issuing and redeeming system. The issuing system, including an issuing station or server located at the manufacturer's or clearinghouse site, generates customized advertisements and electronic coupons. The issuing system further comprises a consumer's computer, located at a consumer's site and coupled to a smart card reader/writer used to receive a smart card input from the consumer. Coupons are selected and downloaded from the issuing station or server over the Internet to the consumer's PC, which transfers the electronic coupons via the smart card reader/writer to the smart card inserted therein. In fact, when a consumer requests via his PC coupons from the issuing station or server over a communication network or the Internet, in response the issuing station transmits related targeted advertisements along with the coupons it generates to the consumer's PC. Furthermore, a program or management module provided by the issuing station runs on the consumer's PC to thereby making sure that the consumer absorbs or reads the entire advertisement

before transferring the coupons to the smart card via the smart card reader/writer linked to the consumer's PC. The consumer can then take the smart card having the coupon data encoded thereon to a participating retailer's POS, which is equipped with the traditional software and hardware in addition to a smart card reader/writer interface capable of reading the consumer's smart card. At the retailer's POS, the customer or consumer or the clerk or cashier inserts the smart card into the smart card reader/writer, which reads the coupon data stored therein and if one or more matches are found between one or more product UPC codes in the smart card and one or more purchased items in the customer's order, then a price reduction is applied to the customer's order and the smart card (microchip-based device) memory is updated accordingly to reflect this redemption (or by deleting expired coupons maintained therein) (fig. 6). The redemption process is secured because of tamper-protected access to the coupons stored in the smart card memory. (See abstract; col. 1: 11-17; col. 1: 50 to col. 2: 57; figs. 1-9; col. 3: 31-40; col. 3: 53-67; col. 4: 9-13; col. 4: 14 to col. 5: 26; col. 6: 21-32; col. 6: 33-46; see claims 3-9 of the present reference).

US Patent 5, 192, 854 to Counts discloses a system wherein a customer using a coupon scanner or portable device scans coupon information from a paper coupon and stores the scanned coupon information into the memory of portable device and wherein the customer takes the portable loaded with the desired coupon data to a store POS where one or more coupons are redeemed during a synchronization process.

WO 98/19229 to Fajkowski discloses a system wherein a customer using a coupon scanner or portable device scans coupon information from a paper coupon and stores the scanned coupon information into the memory of portable device and wherein the customer takes the portable loaded with the desired coupon data to a store POS where one or more coupons are redeemed during a synchronization process.

US Patent 6, 332, 127 to Bandera discloses a system for providing a coupon to a customer wherein the coupon is downloaded from a web server and uploaded on the customer's PDA device for permanent storage and wherein the PDA device is wireless connected to a store POS during a redemption process (figs 9A-9B; col. 9: 49 to col. 10: 31).

US Patent 5, 870, 030 to Deluca discloses a system for providing a coupon to a customer for answering quizzes related to advertisements displayed on the customer's pager and wherein the coupon data are downloaded from a remote system and uploaded on the customer's pager memory for permanent storage and wherein the pager having a bar code related to the stored coupon is scanned during a redemption process at a POS terminal (fig. 8; col. 10: 29 to col. 11: 2; col. 12: 26-45).

US Patent 6, 332, 128 to Nicholson discloses a system for providing a multi-level discount coupons to a customer wherein the discount coupons are encoded on a RF device, such as a transponder.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 3081113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

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After Final-703-872-9327 Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ

06/21/04

*Tanner Team Dara*